

Dkt. 55293-A/JPW/AJM/HA

1634  
#26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Carlos Cordon-Cardo, et al.  
Serial No. : 09/329,917 Examiner: Jehanne Souaya  
Filed : June 10, 1999 Group Art Unit: 1634  
For : MARKERS FOR PROSTATE CANCER

TECH CENTER 1600/2900

FEB 10 2003

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1185 Avenue of the Americas  
New York, New York 10036  
January 28, 2003

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. § 1.181  
TO WITHDRAW HOLDING OF ABANDONMENT

This is a Petition under 37 C.F.R. § 1.181(a)(1) to withdraw the holding of abandonment in the Notice of Abandonment issued December 9, 2002 in connection with the above-identified application. A copy of the December 9, 2002 Notice of Abandonment is attached as **Exhibit A**. 37 C.F.R. § 1.181(f) provides that any petition under § 1.181 should be filed within two months of the action or notice from which relief is requested. Therefore, a petition under 37 C.F.R. § 1.181 to withdraw the December 9, 2002 Notice of Abandonment is due February 9, 2003. Accordingly, this Petition is being timely filed.

The December 9, 2002 Notice indicates that the subject application is abandoned based on applicants' alleged failure to timely file new formal drawings as required in the July 23, 2002

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SECTION OF PETITIONS

Carlos Cordon-Cardo, et al.  
Serial No.: 09/329,917  
Filed: June 10, 1999  
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Notice of Allowance. A copy of the July 23, 2002 Notice of Allowance is attached as **Exhibit B**.

In the July 23, 2002 Notice, the Examiner required applicants to submit new formal drawings including the drawing corrections specified in the July 22, 2002 Notice of Draftsperson's Patent Drawing Review.

In response, on October 23, 2002 and concurrent with the payment of the issue fee, applicants filed a Communication Forwarding Formal Drawings having attached thereto as Exhibit A twelve sheets of new, corrected formal drawings. The October 23, 2002 Communication was timely filed in that it was filed concurrently with payment of the issue fee.

A copy of applicants' October 23, 2002 Communication Forwarding Formal Drawings, including a certificate of mailing, is attached hereto as **Exhibit C**. A copy of a postcard bearing the stamp of the U.S. Patent and Trademark Office confirming receipt thereof is attached hereto as **Exhibit D**.

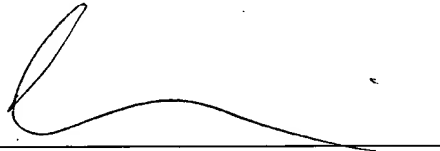
In view of the foregoing, the December 9, 2002 Notice of Abandonment was issued in error and the holding of abandonment set forth therein should be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Carlos Cordon-Cardo, et al.  
Serial No.: 09/329,917  
Filed: June 10, 1999  
Page 3

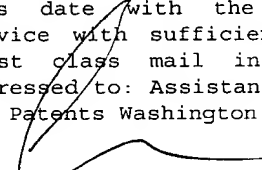
According to M.P.E.P. § 711.03(c)(I), no fee is required in connection with this Petition under 37 C.F.R. § 1.181. Should any fee be required, however, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231.

  
Alan J. Morrison  
Reg. No. 37,399

1/28/03  
Date

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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Carlos Cordon-Cardo, et al.  
Serial No. : 09/329,917 Examiner: J. Souaya  
Filed : June 10, 1999 Group Art Unit: 1634  
For : MARKERS FOR PROSTATE CANCER

Date of Notice  
of Allowance : July 23, 2002 Confirmation No.: 8767

1185 Avenue of the Americas  
New York, New York 10036  
October 23, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

ATTN: OFFICIAL DRAFTSPERSON

COMMUNICATION FORWARDING FORMAL DRAWINGS

This Communication is submitted in response to the Notice of Allowability dated July 23, 2002 which was issued by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the July 23, 2002 Notice of Allowability is due October 23, 2002. Accordingly, this Communication is being timely filed.

In the July 23, 2002 Notice, the Examiner required applicants to submit new formal drawings including the drawing corrections specified in the July 22, 2002 Notice of Draftsperson's Patent Drawing Review. The July 22, 2002 Drawing Review stated that applicant must submit Figure 6 as a Formal Drawing.

In response, applicants attach hereto as **Exhibit A** twelve (10) sheets of new, corrected formal drawings for Figures 1A - 10, including one set of photographs mounted on bryistol board for Figures 1A - 1H, 2A - 2C, 4A - 4F, 5A- 5D, 8A, 8B, and 9A - 9D.

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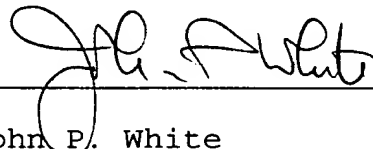
OFFICE OF PETITIONS

Carlos Cordon-Cardo, et al.  
Serial No.: 09/329,917  
Filed: June 10, 1999  
Page 2

Applicants note that the U.S. Patent and Trademark office waived 37 C.F.R. §1.84(b)(1) in a notice published in the August 4, 1998 Official Gazette. Therefore, a petition under 37 C.F.R. §1.84(b)(1) including three sets of photographs mounted on bryistol board and a petition fee of \$130.00 is no longer required for photographs to be accepted.

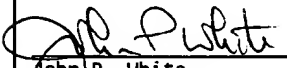
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

 10/23/02  
John P. White Date  
Reg. No. 28,678

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OFFICE OF PETITIONS

FILE

Applicant Carlos Cordon-Cardo, et al.  
Client MSK 1747/55293-A JPW/AJM/HA  
File No. Atty.  
Date January 28, 2003

Kindly acknowledge receipt of the accompanying  
**PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF  
ABANDONMENT** in connection with Carlos Cordon-Cardo, et al., U. S. Serial No.  
09/329,917, filed June 10, 1999, for MARKERS FOR PROSTATE CANCER,  
including Exhibits A-D and Certificate of Mailing dated January 28, 2003.

Date Due: February 9, 2003.

by placing your receiving date stamp hereon and returning to us.

*Station charging: 6/28/03*  
Applicant Carlos Cordon-Cardo, et al.  
Client MSK 1747/55293-A JPW/AJM/HA  
File No. Atty.  
Date January 28, 2003

Kindly acknowledge receipt of the accompanying  
**PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF  
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09/329,917, filed June 10, 1999, for MARKERS FOR PROSTATE CANCER,  
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Date Due: February 9, 2003.

by placing your receiving date stamp hereon and returning to



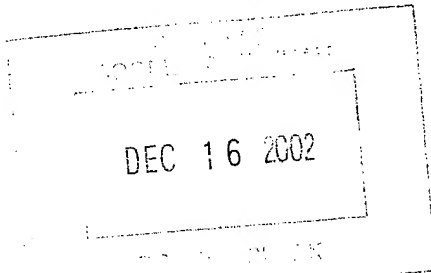


**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

|                    |             |                       |                     |
|--------------------|-------------|-----------------------|---------------------|
| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|-------------|-----------------------|---------------------|

09/329,917



|          |
|----------|
| EXAMINER |
|----------|

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1419

DATE MAILED:

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

2 MO RESP DUE. 2.9.03 - AP

- ☐ Applicant's failure to timely file a proper response to the Office letter mailed on \_\_\_\_\_.
- ☐ A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- ☐ A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.
- (A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)
- ☐ No response has been received.
- ☐ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- ☐ The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.
- ☐ The submitted issue fee of \$\_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.
- ☐ The issue fee has not been received.
- ☒ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.
- ☐ The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.
- ☒ No proposed new formal drawings have been received.
- ☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

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**ABANDONMENT  
CONTACT PERSON IS:  
TOM HAWKINS  
305-8380**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------------------|------------------|
| 09/329,917      | 06/10/1999  | CARLOS CORDON-CARDO  | <del>55293-B/JPW/</del><br>55293-A | 8767             |

7590 12/09/2002  
JOHN P WHITE  
COOPER & DUNHAM LLP  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

|          |
|----------|
| EXAMINER |
|----------|

SOUAYA, JEHANNE E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1634     | PH19         |

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

7590

07/23/2002

JOHN P WHITE  
COOPER & DUNHAM LLP  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER

SOUAYA, JEHANNE E

ART UNIT

CLASS-SUBCLASS

1634

435-006000

DATE MAILED: 07/23/2002

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/329,917      | 06/10/1999  | CARLOS CORDON-CARDO  | 55293-B/IPW/        | 8767             |

TITLE OF INVENTION: MARKERS FOR PROSTATE CANCER

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1280    | \$0             | \$1280           | 10/23/2002 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above. If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

- ☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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55293-A

JPN

**Notice of Allowability**

JUL 26 2002

|                                 |  |                                     |  |
|---------------------------------|--|-------------------------------------|--|
| Application No.<br>09/329,917 ✓ |  | Applicant(s)<br>CORDON-CARDO ET AL. |  |
| Examiner<br>Jehanne Souaya      |  | Art Unit<br>1634                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7-9-02.
2. ☒ The allowed claim(s) is/are 2 and 3.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

IF & DRG DUE. 10.23.02

AP

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS must be submitted.
  - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☒ to Paper No. 15.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. 15.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3 <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>14</u> |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____               | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                     |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance    |
|  | 9 <input type="checkbox"/> Other   |

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### EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Alan Morrison on July 9, 2002.

2. The application has been amended as follows:

Please cancel claims 6-8.

3. The following changes to the drawings are required by the examiner: Figure descriptions in the "Brief Description of the Drawings" are required for the following: Figure 1H has no description in the brief description of the drawings. Fig 2D has no description in the brief description of the drawings. Figs 9A-9F have no description in the brief description of the drawings. The headings for Figs 1-2, and 4-9 in the "Brief description of the drawings" must be changed as follows. The heading for Fig 1 in the brief description of the drawings should be changed from "Figure 1" to --Figure 1A-1H--. The heading for figure 2 in the brief description of the drawings should be changed from "Figure 2" to --Figure 2A-2D--. The same changes should be made to the heading for Figures 4-9 in the "Brief Description of the Drawings". Fig 6 is missing, a new formal drawing for Fig 6 is required. To avoid abandonment of the application, applicant must make these above agreed upon drawing changes.

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Art Unit: 1634

### REASONS FOR ALLOWANCE

4. The following is an examiner's statement of reasons for allowance: The claims are drawn to determining a likelihood that a prostate hyperplasia is a benign prostate hyperplasia by detecting a decrease in p27 RNA expression in a sample of hyperplasia as compared to a normal prostate sample. The claims are also drawn to determining a likelihood that a prostate hyperplasia is a benign prostate hyperplasia by detecting a decrease in p27 RNA expression in a sample of hyperplasia as compared to a normal prostate sample and further comprising determining and comparing the amount of p27 protein expressed in a hyperplasia sample and normal prostate sample. The closest prior art is that of Roberts et al (US Patent 6,316,208) which teaches and claims a method of evaluating a cancer patient's prognosis by determining the level of human p27 protein wherein a reduced level of p27 in the sample correlates with an increased risk for recurrence of a cancer. Roberts further teaches that the cancer can be prostate carcinoma. The claims are allowable over the prior art of Roberts because Roberts does not teach or fairly suggest determining a likelihood that a prostate hyperplasia is a benign prostate hyperplasia by detecting a decrease in p27 RNA expression in a sample of hyperplasia as compared to a normal prostate sample. Further, neither Roberts nor the art in general teach or suggest a correlation between expression of p27 RNA or protein in prostate carcinoma and benign prostate hyperplasia.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

Art Unit: 1634

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Jehanne Souaya*

Jehanne Souaya  
Patent examiner  
Art Unit 1634

7/22/02

*Lisa B. Arthur*  
LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800

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